

REMARKS

Claims 1-28 are in this application. Claims 1-6 and 11-16 are being examined and claims 7-10 and 17-28 have been withdrawn.

Claim 1 has been amended to define the substituents that can substitute a substituted group. Support for this amendment is found on pages 9-11 of the specification.

According to page 2 of the Action, the application has been examined with regard to the elected compound wherein R_1 and R_4 represent non-heteroaryl and non-heterocyclic groups and R_2 , R_3 , a, b, A, B as set forth in claim 1, exclusively. Claim 1 has been amended to delete heterocyclyl and heteroaryl groups from the definition of R_1 . The definition of R_4 in claim 1 has been amended as set out in the claim. Support for this amendment is found throughout the application and in particular in the examples.

According to the Action, claim 1 is rejected under 35 USC 112, first paragraph as failing to comply with the enablement requirement. Claim 1 was also rejected under 35 USC 112, second paragraph as being indefinite for failing to define the term substituted. These are respectfully traversed.

When considering the enablement test, the person who must be able to utilize the specification to make or use the invention is one "skilled in the art to which the invention pertains or with which it is most nearly connected" and so a reasonable degree of expertise can be assumed. The claims of a patent may be drafted broadly to cover the invention described irrespective of whether all possible embodiments have been reduced to practice.

Exactly how much disclosure is needed to support a broad claim is a matter of fact in each case. (See **In re Fisher** (166 USPQ 18 (CCPA 1970))). The key question is the predictability of the art in question, see for example **United States v Teletronics Inc.** 8 USPQ 2d 1217 (Fed Cir 1988) and **PPG Industries v. Guardian**

Industries Corp. 75 F.3d 1558, 37 USPQ2d 1619 (Fed Cir, 1996) where the court held
In unpredictable art areas, this court has refused to find broad generic claims
enabled by specifications that demonstrate the embodiment of only one or a few
embodiments and do not demonstrate with reasonable specificity how to make and
use other potential embodiments across the full scope of the claim. ... [In such cases
undue experimentation is required] ... But the question of undue experimentation is a
matter of degree. The fact that some experimentation is necessary does not
preclude enablement.

The same case also pointed out that in some situations a considerable amount of
experimentation might be permissible if it were routine.

To expedite prosecution, the claims have been amended to define the possible
substituents of the substituted terms based on the description on pages 9 to 11 of the
application. The claims are enabled and definite.

Applicants preserve all rights to file one or more divisional applications for subject
matter disclosed in this application and not presently claimed. Therefore, the claims

Therefore, it is respectfully requested that this rejection be withdrawn.

The issue of filing terminal disclaimers will be deferred until the claims in one or more
of 10/935,708 and 10/475,735 are allowable.

It is the applicants' contention that this application is in condition for allowance and
favorable consideration is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Janet I. Cord", written over a horizontal line.

Janet I. Cord
c/o Ladas & Parry LLP
26 West 61st Street

New York, New York 10023

Reg. No. 33,778, (212-708-1935)

BEST AVAILABLE COPY